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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,394	07/03/2003	John Melideo	J000-P0363US	5950

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EXAMINER

BAUTISTA, XIOMARA L

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/614,394	Applicant(s) MELIDEO, JOHN	
	Examiner X. L. Bautista	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-17, 22-28 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-17, 22-28 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/28/06 & 9/26/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-6, 11-17, 22-28 and 33 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-6, 11-17, 22-28 and 33 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27 of copending Application No. 10/840,889. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 4, 5, 11-13, 15, 16, 22-24, 26, 27 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by *Slotznick* (US 7,058,356 B2).

Claims 1 and 23:

Slotznick discloses a method of displaying telephone numbers on a client computer (col. 2, lines 40-67; col. 3, lines 1-61); in response to the user selecting a data unit for display, scanning the data unit for telephone numbers (col. 8, lines 41-54; col. 12, lines 26-67; col. 13, lines 1-16); packaging an object corresponding to the identified telephone number, the object defining an activatable telephone number and defining a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network (col. 15, lines 37-60, 63-67; col. 16, lines 1-17); the telephone call is initiated between a first telephone

corresponding to a telephone number associated with the user of the client computer and a second telephone corresponding to the identified telephone number (col. 12, lines 58-67; col. 13, lines 1-16; col. 15, lines 4-24, 37-60, 63-67; col. 16, lines 1-28; col. 17, lines 20-65); the first telephone (tvphone; cellphone) and the second telephone (phone service, merchant telephone) are separate and distinct from each other and are separate and distinct from the (set-top box) client computer (col. 7, lines 37-40; col. 8, lines 53-55; col. 9, lines 14-22; col. 15, lines 4-24); when the identified telephone number is displayed as part of a data unit causing the telephone number to have a display attribute which renders the identified telephone number (the telephone number is displayed together with an icon to indicate that it can be activated) conspicuous to the user (col. 12, lines 45-55).

Claim 2:

Slotznick teaches that a telephone number is displayed as a consequence of an instruction to display the data unit (col. 12, lines 26-55).

Claims 4, 15 and 26:

Slotznick teaches the data unit includes displayable data (text) intermixed with non-displayable data (pictures), and that in some applications only some portions of the data (such as text) may be displayed (col. 16, lines 10-18).

Claims 5, 16 and 27:

Slotznick teaches detecting an activation instruction by the user of a

displayed telephone number causing a telephone call to be initiated using the displayed telephone number (col. 12, lines 65-67; col. 13, lines 1-13; col. 15, lines 4-24, 37-60).

Claims 11, 22 and 33:

Slotznick teaches a data unit having an embedded object, which is a hook for allowing initiation of telephone call using the identified telephone number (col. 11, lines 1-11; col. 12, lines 45-55).

Claim 12:

See claim 1. Slotznick teaches a computer system (col. 5, lines 14-18) having a user input device (col. 11, lines 20-23), a display device (col. 5, lines 19-23), a processor and memory (figs. 1C, 2, 15).

Claims 13 and 24:

See claims 2, 5 and 11. Slotznick teaches the invention comprises circuits and software for scanning the data unit as an instruction to display the data unit (col. 5, lines 14-23; col. 17, lines 66-67; col. 18, lines 1-3).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 6, 14, 17, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Slotznick and Giordano, III* (US 6,870,828 B1).

Claims 3, 14 and 25:

Slotznick teaches that data units can be an email message or a web page. Slotznick teaches that only a portion of the data units may be displayed when the display screen is small (col. 4, lines 4-11, 26-41, 64-67; col. 5, lines 1-13). Slotznick does not teach that the data unit is part of a file. However, Giordano discloses a method of scanning data units (web documents), recognizing, displaying, and accessing telephone numbers appearing on the data unit (web page). Giordano teaches that the data unit (web page) is part of a file (col. 3, lines 25-32) and that only portions of the file may be displayed (col. 3, lines 33-43). Therefore, it would have been obvious to one ordinarily skilled in the art at the time of invention to modify Slotznick's method of displaying telephone numbers to include Giordano's teaching of displaying only portions of a file because users are provided only with the necessary information; this is especially convenient for those users having small portable devices having a small screen.

Claims 6, 17 and 28:

Slotznick does not teach display attributes including at least one of a distinctive color, underlining, a distinctive font, highlighting on mouse roll-over,

and right-click menu. However, Giordano discloses a method of recognizing, displaying, and accessing telephone numbers appearing on a web page. The method has a parsing algorithm that recognizes telephone numbers and coding that is added to iconify the telephone numbers, the icons being selectable by a user to place a call. Giordano teaches that the telephone numbers are conspicuously rendered by including a button surrounding the number, font appearance, underlining, or highlighting (col. 2, lines 8-28; col. 3, lines 4-15, 37-49, 57-65; col. 4, lines 20-27). Thus, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify Slotznick's method of teaching of integrating voice and data operations to include Giordano's teaching of providing contact information because it facilitates selection and provides enhancement of contact information for quick identification of telephone numbers.

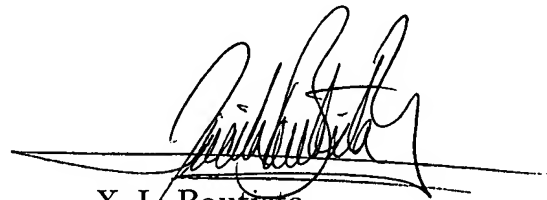
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Tuesday-Friday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



X. L. Bautista
Primary Examiner
Art Unit 2179

xlb
11 October 2006